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EXPERTS IN PATENT CAUSES.

Experts in patent causes have been the subject of criticism and witticism time out of mind. Courts, litigants, and attorneys have inveighed against them. The evil goes on. From the Selden Automobile Case[1] with its thirty-six large octavo volumes of proofs, mostly the work of experts, down to a case before the writer in which nearly one-half of a thousand-page record is the testimony of experts, there is abatement of this misdirected zeal only where the more stringent court rules are enforced. It is not the purpose of this article to dissect this tumor of the law merely to show its malignity, but rather to endeavor to point out a general remedy.

Up to the time of the new Equity Rules,[2] it was the practice to take expert proofs by deposition before notaries who, of course, had no power to rule upon the evidence. Rule 48 of the Supreme Court changes this practice as follows:

> In a case involving the validity or scope of a patent or trademark, the district court may, upon petition, order that the testimony in chief of expert witnesses, whose testimony is directed to matters of opinion, be set forth in affidavits and filed as follows: Those of the plaintiff within forty days after the cause is at issue; those of the defendant within twenty days after plaintiff's time has expired; and rebutting affidavits within fifteen days after the expiration of the time for filing original affidavits. Should the opposite party desire the production of any affiant for cross-exaination, the court or judge shall, on motion, direct that said cross-examination and any reexamination take place before the court upon the trial, and unless the affiant is produced and submits to cross-examination in compliance with such direction, his affidavit shall not be used as evidence in the cause.

Without doubt the operation of this rule has been and will be to reduce the *volume* of expert testimony to some extent in two ways: (1) the direct evidence of the expert, put in the form of an affidavit, is more concise than in the old question-and-answer form; (2) upon cross-examination in open court the judge may rule upon and materially shorten such examinations. But, on the other hand, two things are to be taken into account: (1) that there is no limit to the range of such expert affidavits; (2) that the court must waste much time in hearing the cross-examination, and in the end must read the entire proofs, and thus be involved in a two-fold expenditure of time.

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[1] Columbia Motor Car Co. v. Duerr, 184 Fed. 893 (1911), revising 172 Fed. 923 (1909).

[2] Promulgated by the Supreme Court, November 4, 1912.

Is there, then, no general remedy for this confessed evil in patent practice? The writer ventures the assertion that there is, that it is a most simple remedy residing with the Supreme Court, and therefore requiring no statutory enactment.

It is true that, recently, in some circuits, rules have been made stringently limiting the province of the expert in patent causes. This is but putting in rule form the opinion-criticisms of the courts for many years. But the difficulty with both circuit rule and case law is that they are critical in content rather than constructive in purpose; that they are not uniformly (and perhaps not always wisely) restrictive; and consequently that they tend toward variance in practice in the different circuits. To add to the chaos of state court practice nine different rules in the nine federal circuits would be monstrous when such course is wholly unnecessary.

Before we turn to the rulings of the appellate courts to discover what has been found to be the province of the patent expert, it may be instructive to revert briefly to the main causes or motives which have produced these evils. They divide fairly evenly between expert, counsel, and court.

The expert sees the case at close range and in detail. He is, in large measure, unable to gain the perspective to judge between essentials and non-essentials. As a rule, he is not familiar with the rules of evidence; and even if he is so familiar, the paramount consideration with him is the art which he knows in all detail and all of which he is anxious to disclose. Nor is it to be overlooked that there are, unfortunately, many patent experts who regard their province as practically that of special counsel, and far exceed their rights. This has been recognized and condemned by the courts.[3] Counsel, in their anxiety to leave no point uncovered, readily follow the lead of the expert, rather than direct his activity; and upon cross-examination it is the tendency of counsel to endeavor to break down or weaken the direct statements—generally resulting in strengthening the expert's position, and inevitably resulting in padding the record. The court, in its tendency to give both sides all opportunity, is generally over-indulgent, and permits, especially upon cross-examination, a latitude which helps no one, but rather obscures the issue and burdens court, counsel, and parties alike.

An examination of the appellate rulings as to the province of the expert, while many are negative and critical in character, give distinct boundaries. These may be stated: 1. He may qualify himself to testify;[4] 2. He may explain the patent in suit;[5] 3. He may explain the prior art.[6] Such evidence is necessary when the prior art is complicated,[7] but *only* when the prior art is technical or complex;[8] 4. His testimony is never conclusive.[9]

The expert should, therefore, be limited upon both direct and cross-examination by the first three of these rules; and the fourth rule should establish absolutely a bar to the most common practice, namely, drawing conclusions of law as to infringement or anticipation.

As a matter of fact, though the patent expert rarely states conclusions of law as to novelty, infringement, *etc.*, in bald form; he devotes the greater part of his time to discussions which can have no other object than to conclude the law. And in order to reach such conclusions by round-about argumentation, he necessarily engages in much that is anything but straightforward statement of fact.

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[3] Osgood Dredge Co. v. Metropolitan Dredging Co., 75 Fed. 670; 21 C. C. A. 491 (1896); Ideal Stopper Co. v. Crown Cork and Seal Co., 131 Fed. 244; 65 C. C. A. 436 (1904).

[4] Corning v. Burden, 15 How. 252; 14 L. Ed. 683 (1853).

[5] Winans v. New York & Erie R. R. Co., 21 How. 88; 16 L. Ed. 68 (1858); Loom Co. v. Higgins, 105 U. S. 580, 586; 26 L. Ed. 1177 (1881).

[6] Winans v. New York & Erie R. R. Co., *supra*, n. 5.

[7] Waterman v. Shipman, 55 Fed. 982; 5 C. C. A. 371 (1893).

[8] Krupp v. Midvale Steel Co., 191 Fed. 588; 112 C. C. A. 194 (1911).

[9] Am. Delinter Co. v. American Machinery Co., 128 Fed. 709; 63 C. C. A. 307 (1904).

Even in seemingly complicated cases involving problems on the margin of known science, the actual issue, brought down to its last analysis of patentability or infringement, is in but few cases, complex. What is complicated is the voluminous and largely inconsequential evidence; and this is particularly the case where the subject-matter is some organic composition, or some chemical reaction or physical action beyond actual knowledge. And to spend days in discussion of chemical or physical theory to prove that the thing cannot be proved leads nowhere and lands at the same place. To make this point more specific, taken certain questions, for example, of hydrocarbon conversion. By no known method can a chemist tell to the last unit exactly what the component parts of certain hydrocarbons are. To start with, he is dealing with a product of nature which he cannot analyze; and when he puts it through a process of conversion he has a product which he cannot reduce absolutely to known parts or proportions. By a long disquisition in chemistry and physics, what has the expert done to enable the court to answer the three questions he must ask and answer before he can decide the case? These questions are: 1. What is the claimed feature of the plaintiff's patent? 2. Does the defendant use such claimed feature? 3. Is such claimed feature novel?

The court is not concerned with the scientific problems beyond enablement to answer these three questions. It is well known that the scientific fact or theory cuts no figure except as a side-light; for a patentee is not charged with such scientific knowledge.[10] All the patentee has to do is to show how to produce the desired result, and this he does by a plain statement of the steps or combinations he employs. These can be stated in a one-two-three order. Then the question is whether the defendant has employed the same steps or combination, or their fair equivalent; and this is, or should be, a one-two-three proposition. The third question is, are these steps or combinations found in the prior art? Either they are or they are not, and the determination of whether the prior art shows such steps or combinations does not require hundreds of pages of testimony, but is rather a comparison of elements, steps, or combinations, and identity or diversity of result.[11]

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[10] Eames v. Andrews, 122 U. S. 40; 30 L. Ed. 1084 (1887); Emerson v. Nimocks, 99 Fed. 737; 40 C. C. A. 87 (1900).

To illustrate the above, let us take the claim of the Selden Automobile Patent which, as already stated, took thirty-six large volumes of printed evidence to elucidate for the court. This claim reads:

> 1. The combination with a road locomotive, provided with suitable running gear, including a propelling wheel and steering mechanism, of a liquid hydrocarbon gas-engine of the compression type, comprising one or more cylinders, a suitable liquid fuel receptacle, a power shaft connected with and arranged to run faster than the propelling wheel, an intermediate clutch or disconnecting device and a suitable carriage body adapted to the conveyance of persons or goods, substantially as described.

If, now, we make a broad analysis of this claim by the one-two-three method we have: 1. Running gear; 2. Gas engine of the compression type; 3. Fuel receptacle; 4. Power shaft; 5. Clutch; 6. Carriage body. These are the main elements. They might be, of course, qualified and refined, but they are sufficient for our purposes of illustration.

Compare these elements with the combination used by the defendants, and we find: 1. Running gear? Yes. 2. Gas engine of the compression type? Selden used the old Brayton engine; defendants used an engine of the Otto type. Here was the crux of the case. 3. Fuel receptacle? Yes. 4. Power shaft? Yes. 5. Clutch? Yes. 6. Carriage body? Yes. Hence the *one* question was whether the old Brayton engine was inclusive of the later Otto engine—the high-compression engine which made the automobile a practical, operative machine.

The question in its last analysis was a question of law for the court. An expert could do no more than show what the earlier engine was and its capabilities, and show what the later engine was and how it extended those capabilities.

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[11] Electric Signal Co. v. Hall Signal Co., 114 U. S. 87; 29 L. Ed. 96 (1885).

Had the expert evidence been strictly limited to those propositions, there never could have been such a mass of evidence; and it is an open question whether this befogging of the issue was not the cause of the wholly different views of the trial and appellate courts.[12]

While there are cases wherein so simple and straightforward analysis is not possible, they are the exceptions; and even in such cases there is no reason why the method and procedure pointed out should not be applied.

Hence, the remedy: Since the Supreme Court has, in part, regulated the taking of expert testimony in patent causes by the equity rule above quoted, it might well add a single paragraph embodying the appellate rulings stated, and thus at once largely remedy the evil and make the practice uniform throughout the nine circuits.

While the phrasing of such an addition to Equity Rule 48 is for the master-mind that wrote those rules—a feat probably unequaled in the history of legislation or decision—there is no doubt that such a rule could be drawn within the four corners of fixed law which, in conclusion, may be summarized as follows: The province of the expert in patent causes is, 1, to qualify himself to testify; 2, to explain the patent in suit; 3, to explain the prior art when recondite or complex; 4, never to draw conclusions of law.

William Macomber.

Buffalo.

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[12] 172 Fed. 923 (1909) and 184 Fed. 893; 107 C. C. A. 215 (1911), *supra*, n. 1.